



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,689	04/16/2004	Steven F. Bierman	VINTL.125CP1	9584

20995 7590 12/15/2004

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

PATEL, MITAL B

ART UNIT PAPER NUMBER

3743

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,689

Applicant(s)

BIERMAN, STEVEN F.

Examiner

Mital B. Patel

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/15/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. It is noted that this application appears to claim subject matter disclosed in prior Application No. 10/270,883, filed 10/11/02. Although a reference to the prior application has been inserted as the first sentence of the specification of this application or in an application data sheet (37 CFR 1.76, **the current status of all nonprovisional parent applications referenced should be included.**

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35

Art Unit: 3743

U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 respectively of U.S.

Patent No. 6,796,310. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are more specific than

Art Unit: 3743

the application claims. As such, the patented claims "anticipate" the application claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

4. **Claim 1 of the application recites** an endotracheal tube securement device comprising (**See line 1 of claim 1 of patent**): a head contact member having a central region and at least a pair of securing regions, one of the pair of securing regions extending from each lateral side of the head contact member, each securing region having at least one opening, and arranged such that the openings of the pair of securing regions are accessible to each lateral side of the head contact member (**See lines 2-10 of claim 1 of patent**); and a plurality of securing members, each securing member having a first end and a second end, the first end having a hook region upon which the hooks of a hook and loop fastener are disposed and a loop region upon which the loops of a hook and loop fastener are disposed, and the second end having a fastener configured to attach the member to an endotracheal tube to be secured in position upon the head of a patient, each of the plurality of securing members configured to be attached to the head contact member by passing the first end of the securing member through one of the openings of the head contact member and then attaching the hook region of the securing member to the loop region of the securing member to secure the member to the head contact member (**See lines 11-23 of claim 1 of patent**). The difference between claim 1 of the application and claim 1 of the patent lies in the fact that the patent claim includes additional elements and is thus more specific. Thus the invention of claim 1 of the patent is in effect a "species" of the "generic" invention of claim 1 of the application. It has been held that the generic invention is "anticipated" by

Art Unit: 3743

the "species" and thus, is not patentably distinct. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

5. **As to claim 2 of the application**, the limitations can be found in claim 2 of the patent.

6. **As to claim 3 of the application**, the limitations can be found in claim 3 of the patent.

7. **As to claim 4 of the application**, the limitations can be found in claim 4 of the patent.

8. **As to claim 5 of the application**, the limitations can be found in claim 5 of the patent.

9. **As to claim 6 of the application**, the limitations can be found in claim 6 of the patent.

10. **As to claim 7 of the application**, the limitations can be found in claim 7 of the patent.

11. **Claim 8 of the application recites** a medical tube securement system comprising (**See line 1 of claim 8 of patent**): a medical tube to be secured in position upon the head of a patient; a head contact member having a central region and at least a pair of securing regions, one of the pair of securing regions extending from each lateral side of the head contact member, each securing region having at least one opening formed in it (**See lines 2-9 of claim 8 of patent**); and a plurality of securing members, each securing member having a first end and a second end, the first end having a hook region upon which the hooks of a hook and loop fastener are disposed

Art Unit: 3743

and a loop region upon which the loops of a hook and loop fastener are disposed, and the second end having a fastener configured to attach the securing member to the medical tube, each of the plurality of securing members configured to be attached to the head contact member by passing the first end of the member through one of the openings of the head contact member and then attaching the hook region of the securing member to the loop region of the securing member to secure the securing member to the head contact member (**See lines 10-21 of claim 8 of patent**). The difference between claim 8 of the application and claim 8 of the patent lies in the fact that the patent claim includes additional elements and is thus more specific. Thus the invention of claim 8 of the patent is in effect a "species" of the "generic" invention of claim 8 of the application. It has been held that the generic invention is "anticipated" by the "species" and thus, is not patentably distinct. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

12. **As to claim 9 of the application**, the limitations can be found in claim 9 of the patent.

13. **As to claim 10 of the application**, the limitations can be found in claim 10 of the patent.

14. **As to claim 11 of the application**, the limitations can be found in claim 11 of the patent.

15. **As to claim 12 of the application**, the limitations can be found in claim 12 of the patent.

Art Unit: 3743

16. **As to claim 13 of the application**, the limitations can be found in claim 13 of the patent.

17. **Claim 14 of the application recites** a system for securing a medical article to the head of a patient comprising (**See lines 1-2 of claim 14 of patent**): a head contact member having a central region and at least a pair of securing regions, one of the pair of securing regions extending from each lateral side of the head contact member, each securing region having a plurality of openings formed in it (**See lines 3-8 of claim 14 of patent**); a plurality of securing members, each securing member having a first end and a second end, the first end having a hook region upon which the hooks of a hook and loop fastener are disposed and a loop region upon which the loops of a hook and loop fastener are disposed, and the second end having a first fastener element, each of the plurality of securing members configured to be attached to the head contact member by passing the first end of the securing member through one of the openings of the head contact member and then attaching the hook region of the securing member to the loop region of the securing member to secure the member to the head contact member (**See lines 9-20 of claim 14 of patent**); and an attachable fastener unit comprising a support member and at least one second fastener element disposed upon the support member, the support member configured to be attached to the medical article and the second fastener element configured to cooperate with the first fastener element to attach a securing member to the attachable fastener unit (**See lines 21-27 of claim 14 of patent**). The difference between claim 14 of the application and claim 14 of the patent lies in the fact that the patent claim includes additional elements and is thus more

Art Unit: 3743

specific. Thus the invention of claim 14 of the patent is in effect a "species" of the "generic" invention of claim 14 of the application. It has been held that the generic invention is "anticipated" by the "species" and thus, is not patentably distinct. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

18. **As to claim 15 of the application**, the limitations can be found in claim 15 of the patent.

19. **As to claim 16 of the application**, the limitations can be found in claim 16 of the patent.

Conclusion

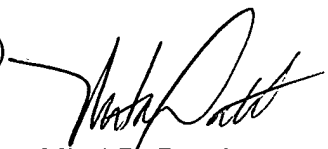
20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6336457.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mital B. Patel whose telephone number is 571-272-4802. The examiner can normally be reached on Monday-Friday (11:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



12/10/04

Mital B. Patel
Examiner
Art Unit 3743